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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,523	01/27/2004	Kenji Nakashima	1341.1177	9957
21171 7590 04/09/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER ALLEN, WILLIAM J	
			ART UNIT 3625	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/09/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/764,523

Applicant(s)

NAKASHIMA, KENJI

Examiner

William J. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

Claims 1-10 and 12-24 are pending.

Claim 24 stands withdrawn as of this action.

Claims 1-10 and 12-23 are pending and rejected as set forth below.

Response to Arguments

Applicant's arguments filed 10/10/2006, with respect to the rejection(s) of have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Niki in view of Morrisroe.

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Election/Restrictions

Newly submitted claim 24 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 and 12-23, drawn to an apparatus, method, and computer program for providing group purchasing services, classified in class 705, subclass 26.
- II. Claim 24, drawn to a method for providing a group purchasing service, classified in class 705, subclass 26.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as receiving a registration request from a plurality of users associated with a group purchasing request and issuing unique user identification information to the plurality of users corresponding to the group purchasing request, in response to the registration request. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 24 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-10 and 12-13 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” *The New IEEE Standard Dictionary of Electrical and Electronics Terms* 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally

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interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

In this regard, claim 1 recites various “units” for which it is unclear of whether these “units” constitute structural elements. More specifically, in Applicant’s own specification, these elements are not limited to structural elements, noting that “the whole or part of the processing functions of each apparatus is realized by a CPU or a program...”. In other words, these “units” may solely comprise a computer program, and are therefore non-statutory.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-6, 9, 12-18, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niki et al. (US 20020037257) in view of Morrisroe (US 20030229542).**

Regarding claim 1, Niki teaches:

an identification information issuing unit that issues, upon receiving a group purchasing application request for a product from a user terminal, user identification information corresponding to the group purchasing application request (see at least: Fig. 1, abstract, 0042, 0056, 0070, 0144); and

a product purchasing execution unit that executes, upon receiving a purchasing procedure request for a product from the user terminal with the user identification information issued, a product purchasing procedure for a user who made the purchasing procedure request (see at least: Fig. 1 and 5, 0041-0049, 0053-0060),

and sets the user as an object user for the group purchasing processing corresponding to the user identification information (see at least: 0030, 0037, 0041-0042, 0135, Fig. 10);

an identification information storing unit that stores, upon the identification information issuing unit receiving a group purchasing application request for a product including at least a plural pieces of user identification information to identify a plurality of users, respectively, the

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user identification information of the users (see at least: 0038, 0042-0044, 0066, 0070, 0072, 0079, 0099, 0105, 0133, 0056, 0072, Fig. 1(II-III), 7(s4), and 9).

Niki teaches all of the above as noted and further teaches where a leader of a bulk purchasing group accesses the group purchasing system and creates a group purchasing request via a terminal. Subsequently, each additional member of the group purchase is informed of an ID to access the group purchasing system, thereby “urging” the users to complete a purchase via the group purchasing system using the ID in order to obtain a discount (see at least: abstract, 0041-0045, 0056-0057, Fig. 9). Furthermore, in response to the transmitted message informing the additional member of the ID, a customer performs a purchase operation and is set as an object user for the group purchasing process (see at least: 0135, Fig. 10). Niki, despite these teachings, does not teach where the leader accesses the system *with user identification information which coincides with the user identification information stored in the identification information storing unit*.

In the same field of endeavor, Morrisroe teaches a system for electronic marketing and sales advertising that presents dynamic “advertisements” to users (see at least: abstract, 0008-0010). More specifically, Morrisroe teaches where a user logs in using a username and password associated with the user’s profile (i.e. *user identification coinciding with stored user identification information*). Using that information, the presented advertisements can include differing versions based on the information extracted about the user, thereby providing an add tailored to be effective to the user (see at least: 0036-0037). Furthermore, these adds may be

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tailored to various scenarios, such as calendar reminders (0039), product upgrades (0040), and, most importantly, to alert users of impending expirations such as bidding in an online auction (0041). In any case, displaying tailored advertisements such as these including the time elapsed are used to generate a sense of urgency, thereby encouraging purchase or appropriate action by the user before the expiration (see at least: 0021).

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Niki to have included *with user identification information which coincides with the user identification information stored in the identification information storing unit* as taught by Morrisroe in order to provide a system that presents tailored adds to create a sense of urgency, thereby encouraging purchase or appropriate action by the user before the expiration (see at least: Morrisroe, 0021).

Regarding claims 2-6, 9, 12-18, and 20-23, Niki in view of Morrisroe teaches:

(2) *wherein the product purchasing execution unit executes, upon receiving a group purchasing procedure request for a different kind of product based on the group purchasing with the user identification information from the user terminal, the product purchasing procedure for a user who made the group purchasing procedure request (see at least: Niki , 0068, 0138-0140, Fig. 11).*

(3) *an identification information transmitting unit that transmits the user identification information issued from the identification information issuing unit to the user terminal, wherein the product purchasing procedure execution processor receives the product purchasing procedure request with the user identification information transmitted (see at least: Niki , Fig. 1 and 3, abstract, 0042, 0056, 0070).*

(4) *wherein the identification information issuing unit receives a group purchasing application request indicating a group purchasing of a product for a predetermined number of persons from the user terminal (see at least: Niki , 0004, 0042-0043). The Examiner notes that the purchaser side specifies the members of the bulk purchase group when requesting a bulk purchase of products. The specification of members done so as part of the request constitutes a pre-determined number of participants.*

(5) *a shipping processing request unit that makes a processing request for shipping a product to a user who uses the user terminal when the product purchasing execution unit executed the product purchasing procedure (see at least: Niki , 0040, 0058).*

(6) *a discount amount calculating unit that calculates, after the product purchasing execution unit completes execution of the product purchasing procedure for each user, a*

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discount amount for a product to be paid back to the user corresponding to number of the object users for the group purchasing processing; and a discount amount output unit that outputs the discount amount calculated (see at least: Niki , 0110-0115, 0123-0128, Fig. 6 and 8).

(9) wherein the identification information issuing unit issues a uniform resource locator of last page of either of the processing of the group purchasing application request and the purchasing procedure request (see at least: Niki , 0034, 0066-0068, Fig. 11-13). The Examiner notes that a homepage provides access to the contents concerning a bulk purchase group, with each individual bulk purchasing page on the WWW server representing an individual page for that group purchase. Each individual web page has an assigned URL.

(12) an expiration date creating unit that creates an expiration date of the user identification information issued by the identification information issuing unit (see at least: Niki , 0014, 0050, 0061, 0096, 0107, 0127-0128);

wherein the product purchasing execution unit sets, upon receiving the product purchasing procedure request with the user identification information, a user who made the purchasing procedure request as the object user for the group purchasing processing corresponding to the user identification information, if the expiration date of the user identification information is valid (see at least: Niki , 0107-0108, 0135, Fig. 5, Fig. 10).

(13) a user information management unit that manages information on each user included in the product purchasing procedure request by associating the information with the group who made the group purchasing application (see at least: 0042-0043, 0056, 0070).

(21) wherein the message transmitting unit transmits a message directly to the user terminals of the users, upon the apparatus receiving an access from a first user terminal of the

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users with user identification information which coincides with the user identification information stored in the identification information storing unit, to urge the users to carry out the group purchasing (see at least: Niki, abstract, 0041-0045, 0056-0057, 0070, 0076, 0159, Fig. 9; Morrisroe, abstract, 0036-0037, 0039-0041).

Regarding claims 14-18, 20, and 22-23, these closely parallel claims 1-6, 9, 12-13, and 21. Claims 14-18, 20, and 22-23 are thereby rejected under the same rationale for at least the reasons above.

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3. **Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niki in view of Morrisroe, as applied above, and further in view of Tiley et al. (US 20010032443.**

Regarding claim 7, Niki in view of Morrisroe teaches all of the above and teaches calculating discounts/refund amounts for a bulk purchase group (see at least: 0110-0115, 0123-0128, Fig. 6 and 8). Niki in view of Morrisroe, however, does not expressly teach wherein the discount is calculated as *a credit point*. Tiley teaches calculating various discounts and in store credits (i.e. *credit points*) to provide incentives to shoppers (see at least: 0043, 0049, 0136-0138). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Niki in view of Morrisroe to have included discount amounts in the form of *credit points* as taught by Tiley in order to provide store owners/retailers a system that motivates purchasers to visit their stores (see at least: Tiley, 0049).

Regarding claim 8, Niki in view of Morrisroe teaches all of the above and teaches calculating discounts/refund amounts for a bulk purchase group (see at least: 0110-0115, 0123-0128, Fig. 6 and 8). Niki in view of Morrisroe, however, does not expressly teach where the discount amount is calculated *based on a destination area for shipping each product*. Tiley teaches providing incentives for retrieving purchases at specific locations. Purchasers and retailers are permitted to have a package delivered to a specific remote location (i.e. *destination area*) for package pick (see at least: 0058, 0074, 0147-0148). Each remote location/destination provides information about the types of incentives they will provide, with the administrator calculating relevant incentives, such as discounted/reduced shipping costs, according to weighing

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factors provided by the retailers (see at least: 0048, 0107). The uniquely calculated incentives are then provided for view and selection to the purchaser (see at least: 0063, Fig. 1). The Examiner notes that because each remote location, and thereby destination area for a product to be delivered and picked up, has uniquely calculated incentives, Tiley teaches where the discount amount is calculated *based on a destination area for shipping*. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Niki in view of Morrisroe to have included discount amounts in the form of *credit points* as taught by Tiley in order to provide store owners/retailers a system that motivates purchasers to visit their stores (see at least: Tiley, 0049).

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4. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niki in view of Morrisroe, as applied above, and further in view of Yoshimine et al. (US 20020138827).

Regarding claims 10 and 19, Niki in view of Morrisroe teaches all of the above as noted and further teaches *creating a website exclusive for a group carrying out the product purchasing procedure* (see at least: 0023, 0042-0044, 0145, Fig. 12 and 13). Each individual bulk purchasing site on the WWW server represents an individual site for that specific group purchase request. Though the contents of the homepage are open to the public, group purchase members/purchasers are identified in the registration of the group purchasing request and use an ID that enables the group members/purchasers to place an order. Niki in view of Morrisroe, however, does not teach *wherein the issuing includes issuing a uniform resource locator of the website created as the user identification information*. Yoshimine teaches *wherein the issuing includes issuing a uniform resource locator of the website created as the user identification information* by determining an appropriate URL corresponding to a user ID (see at least: 0112-0114, 0117, 0122). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Niki in view of Morrisroe to have included *wherein the issuing includes issuing a uniform resource locator of the website created as the user identification information* as taught by Yoshimine in order to provide users with an unmistakable identifying URL through use of familiar indicia such as a most highly desired user ID (see at least: Yoshimine, 0072, 0112).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
March 30, 2007


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